

AMENDMENTS TO THE DRAWINGS:

None

REMARKS/DISCUSSION:

This Amendment B is being filed concurrently with an RCE. A Notice of Appeal was filed in this case on September 16, 2004 and a five-month extension of time is being filed concurrently herewith in order to maintain pendency to allow the filing of the RCE.

By this Amendment B, claims 21-25 and 27-32 are pending in this application. Claims 1-20 and 26 have been canceled. Support for the amendments to claims 21 and 24 and new claims 29-32 can be found in Figures 1, 2B and 23 along with the corresponding description. Accordingly, no new matter is added by these amendments or new claims.

Applicant has carefully studied the outstanding Office Action. This Amendment is intended to be fully responsive to all points of rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application are respectfully requested.

Rejection under 35 U.S.C. § 102(e)

Claims 21-24, 27 and 28 stand rejected as being anticipated by U.S. Patent No. 6,117,152 to Huitema as noted in the Office Action. Independent claims 21 and 24 have been amended to recite a rotatable element operatively associated with the waveguide and blade, the rotatable element being rotated to cause rotation of the waveguide and blade about a longitudinal axis of the instrument. A rotatable element to rotate the waveguide and the blade is neither disclosed nor suggested in the Huitema reference. By reason of dependency, claims 22, 23, 27 and 28 are also patentable over Huitema.

Claims 21-23 stand rejected as being anticipated by U.S. Patent No. 6,283,981 to Beaupre as noted in the Office Action. Independent claim 21 has been amended to recite a rotatable element operatively associated with the waveguide and blade, the rotatable element being rotated to cause rotation of the waveguide and blade about a longitudinal axis of the instrument. A

rotatable element to rotate the waveguide and the blade is neither disclosed nor suggested in the Beaupre reference. By reason of dependency, claims 22 and 23 are also patentable over Beaupre.

Further, Applicant respectfully disagrees with the Examiner's interpretation of what Beaupre discloses. The Examiner's attention is initially directed to column 3, line 48 through col. 4, line 7. Specifically, Beaupre teaches a treatment region 26 and a *separate* balance region 28—not a treatment region *comprising* a balance region as stated by the Examiner. A convex bottom surface (32) and a central ridge (37) are included within the treatment region 26—and are not disclosed to be balance portions as asserted by the Examiner. Further, and quite clearly, Beaupre teaches within the balance region 28 a first cutout 38 and a second cutout 40, *which act as asymmetric balance features*. Beaupre neither discloses nor suggests balance features within the treatment region as is claimed by Applicant.

The Beaupre Patent goes on to state:

In an ultrasonic instrument designed according to the method of the present invention, the balance portion generally extends from a node point on the ultrasonic transmission rod to the *proximal end of the treatment portion*.

(Col. 2, lines 51-55, *emphasis added*).

The Beaupre Patent teaches a treatment portion 26 comprising a functional feature known as a functional asymmetry. Specifically, the treatment portion is the area of the blade that contacts the tissue that is under treatment by the ultrasonic surgical instrument. Proximal to the treatment portion 26 is a balance region 28 where balance features are incorporated. Proximal to the balance region 28 is the ultrasonic transmission rod (see Figs. 2-9 of the Beaupre Patent).

See also, page 4, lines 12-15 of the instant application. "While U.S. patent application Ser. No. 09/106,686 [a related Beaupre application] has proven eminently successful at balancing blades and waveguides *proximal to the balance asymmetry*, there are some applications where some balancing may

be desirable within *the functional portion* of an asymmetric blade." (*emphasis added*)

The instant invention discloses and claims balancing *within* the functional portion (i.e. the curved treatment portion) of an asymmetric blade as clearly recited in claim 21.

a curved treatment portion, and *the curved treatment portion comprising*
at least one functional asymmetry, wherein the functional asymmetry is positioned to counter torque created by the curved treatment portion. (*emphasis added*)

Rejection under 35 U.S.C. § 103

Claims 24 and 25 stand rejected as being unpatentable over Beaupre '981 in view of Huitema '152. Based on the amendments to claim 24 and the previous discussions, neither Beaupre nor Huitema, alone or in combination, disclose or suggest the claimed invention.

Applicant's Response to the Examiner's Response to Arguments

In paragraph 12, the Examiner states "in view of the arguments on page 7 of the applicant's response, the blade will be considered the entire metal structure of figure 23 including elements 179 and 88." Applicant disagrees with the Examiner's definition or interpretation of what defines the blade. Applicant has reviewed the comments on page 7 referred to by the Examiner, and it is unclear how the Examiner can make such a comment, especially considering that nowhere on page 7 of applicant's response is there any mention of element 179. The specification is replete with reference to the ultrasonic waveguide 179 and blade 88. Nowhere in the specification is there any disclosure that the blade 88 includes ultrasonic waveguide 179. Applicant does not consider the blade to be the entire metal structure of figure 23 including elements 179 and 88. There is no support in the specification or Applicant's comments that would allow the Examiner to take such a position.

In paragraph 16, the Examiner states (referring to the Beaupre reference) "Elements 32 and 37 change the center of gravity of the treatment section. This changes the balance of the treatment section. An element that changes the balance of the treatment section is within the scope of a treatment section comprising a balance portion." Applicant disagrees with the Examiner's interpretation of the teachings of Beaupre.

First and foremost, the present application teaches and claims a:

a blade connected to the distal end of the waveguide,
wherein the blade comprises:
a distal end;
a proximal end connected to the waveguide; and
a curved treatment portion including at least one
functional asymmetry, wherein the functional
asymmetry is positioned to counter torque created by
the curved treatment portion

Beaupre specifically teaches away from the claimed invention. "[t]he addition of balance features within the treatment region is undesirable, the blade must be balanced using an alternative method." Col. 5, lines 8-10, emphasis added. Further, Beaupre teaches that it is the treatment region 26 that unbalances end effector 12 (or blade). Col. 5, lines 1-15. Therefore, the Examiner's assertion that "the treatment section is within the scope of a treatment section comprising a balance portion" is 180° out of phase with the teachings of Beaupre. Rather, Beaupre teaches that section 28 is the balancing section that balances the unbalanced section 26.

Conclusion

Applicant submits that in view of the discussion, the rejections under 35 U.S.C. §§ 102(e) and 103 have been overcome and that the invention is now patentable over the cited prior. The Examiner is respectfully requested to reconsider all rejections and pass this case to issue.

Should any minor points remain prior to issuance of a Notice of Allowance, the Examiner is requested to telephone the undersigned at the below-listed telephone number.

The Commissioner is hereby authorized to charge any additional fees, which may be required to Account No. 10-0750/END-736/VEK.

Respectfully submitted,

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